



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/022,779	02/12/98	HENRY	R ACD-2-016

IM22/1115  
TIMOTHY E NAUMAN  
FAY SHARPE BEALL FAGAN MINNICH & MCKEE  
1100 SUPERIOR AVENUE  
SUITE 700  
CLEVELAND OH 44114-2518

EXAMINER

CROSS, L

ART UNIT

PAPER NUMBER

1721

13

DATE MAILED:

11/15/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/022,779

Applicant(s)  
Henry, Richard

Examiner  
Cross, LaToya I.

Group Art Unit  
1721



☒ Responsive to communication(s) filed on Feb 12, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-40 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-40 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 11

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1721

### DETAILED ACTION

The instant application is a continued prosecution application having an effective filing date of February 12, 1998. Claims 1-40 are pending in the instant application.

#### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Publication 08302316 to Yoshitaka et al (herein referred to as Yoshitaka et al '316).

Applicant's claimed invention is directed to a solvent resin composition consisting essentially of a solvent component, present in an amount of 5-95% by weight of the total composition, and a resin component. Each of the solvents is a zero volatile organic solvent and also non-ground based ozone forming.

Yoshitaka et al '316 teaches rubber base adhesive compositions comprising a solvent component and a rubber component (resin). The solvent component does not require the use of volatile and flammable solvents. The solvents are present in an amount of about 50% by weight. Yoshitaka et al '316 disclose the use of solvents such as aliphatic hydrocarbons, acetone, ethyl

Art Unit: 1721

acetate, propyl acetate, 1,1,1-trichloroethane, and methylene chloride. As the rubber component, Yoshitaka et al '316 disclose the use of rubbers such as chloroprene, styrene butadiene, butyl rubber, polyurethane, etc.

Yoshitaka et al '316 differ from the instantly claimed invention in that while the reference teaches the use of non-volatile solvents similar to those instantly claimed by Applicant, the reference does not specifically teach some of Applicants' claimed solvents. For example, Applicant's claim the use of n-propyl bromide (bromopropane), methylene chloride and acetone as volatile solvents which Yoshitaka et al '316 specifically teach. With respect to Applicants' claimed n-alkane (C12-C18), Yoshitaka et al '316 broadly teach the use of aliphatic hydrocarbons which embrace Applicants claimed n-alkane (C12-C18). Applicants' claim the use of methyl acetate and t-butyl acetate, while the reference teaches the use of ethyl acetate and propyl acetate. One of ordinary skill in the art would expect that Applicant's claimed methyl acetate and t-butyl acetate, both being similar to the acetates of the reference, would be suitable to use in such environmentally friendly compositions. Since the reference teaches solvents similar to those instantly claimed and since the reference teaches the use of solvents which are non-volatile and non-flammable, just as Applicant, it would have been obvious to one of ordinary skill in the art to make a composition consisting essentially of a solvent component and a resin component, wherein the solvent component comprises only solvents which are non-volatile and non-flammable. Yoshitaka et al '316 seeks to solve the same environmental problems, concerning the use of environmentally harmful solvents, as Applicants. Acknowledging the

Art Unit: 1721

problems arising from the use volatile solvents, it would have been obvious to one of ordinary art to use only non-volatile solvents such as those instantly claimed by Applicant in such compositions. While Yoshitaka et al '316 may not list the exact non-volatile solvents as Applicant claims, Yoshitaka et al '316 provides the motivation to use such non-volatile solvent in his disclosure that volatile solvents create environmental problems.

Therefore, for the reasons set forth above, Applicant's claimed invention is deemed to be obvious, within the meaning of 35 USC 103, in view of the teachings of Yoshitaka et al '316.

***Declaration under 35 CFR 1.131***

The declaration filed on October 26, 1999 has been considered and made a part of the record. The declaration is sufficient to overcome any rejections under 35 USC 102, however, it is the position of the Examiner that the declaration is not sufficient to overcome a rejection under 35 USC 103, as given above.

Art Unit: 1721

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is (703) 305-7360. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gabrielle Brouillette, can be reached at (703) 308-0756. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

LIC *SLC*  
November 9, 1999

*G. Brouillette*  
GABRIELLE BROUILLETTE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1701